

## **Remarks/Arguments**

### **I. STATUS OF THE CLAIMS**

Claims 2 - 5, 8 -16, 19 – 33, 39 - 43, 46 - 54, and 57 - 71 are pending in this application. Claims 6, 7, 18, 34-37, 44, 45, 56, and 72-75 have been cancelled in this amendment. Claim 3 has been amended to include features previously recited in cancelled claims 6 and 7. Claim 12 has been further amended to include features previously recited in cancelled claim 18. Claim 41 has been further amended to include features previously recited in cancelled claims 44 and 45. Claim 50 has been amended to include features previously recited in cancelled claim 56. Claims 8 and 46 have been amended for clarification without changing their scope. Claims 58 and 71 have been amended for grammar or clarification without changing its scope.

### **II. Rejections Under 35 U.S.C. § 112**

Claims 8, 19-20, 46, and 57-58 stand rejected under 35 U.S.C. § 112 as being indefinite based on use of the phrase, “may, or may not.” This phrase has been removed, and alternative wording has been added to preserve the same scope of the claim language. Claims 8 and 46 are further rejected for using the phrase “and/or.” This term has been removed and alternative language applied with a same scope. Accordingly, these rejections may be withdrawn.

### **III. Rejections Under 35 U.S.C. § 102(b)**

Pending claims 2-6, 12-16, 21-24, 31, 34, 36, 37, 39-41, 50-54, 59-62, 72, 74, and 75 stand rejected as being anticipated by U.S. Patent 5,058,030 to Schumacher, (“Schumacher”). Independent claims 3, 12, 41 and 50 have been amended to include features of previous claims 7, 18, 45, and 56, all of which were previously rejected

under §103 obviousness. Accordingly, it is submitted that the §102 rejections of these claims may be withdrawn and the §103 issues will be addressed below.

#### **IV Rejections Under 35 U.S.C. § 103(a)**

##### **Rejections based on Schumacher alone.**

Pending claims 19, 32, 33, 35, 42-44, 57 are rejected as obvious in view of Schumacher alone. Independent claims 3, 12, 41 and 50 have been amended to include features of previous claims 7, 18, 45, and 56, all of which were previously rejected under §103 obviousness.

##### ***Claims 3 and 41***

These claims recite marketing rules that are used to determine whether messages with particular marketing content may, or may not, be combined. The Examiner, has acknowledged that Schumacher does not disclose these features, but asserts that known privacy considerations would have made those features obvious. Even assuming that the unsupported motivation of “privacy” existed, there is no nexus between the alleged privacy considerations and the feature recited in the claims. The claims are directed to whether particular marketing content can be consolidated. There is no privacy concern that is being addressed by these features. Accordingly, the Examiner has not identified any prior art, or any relevant basis, for finding that these features were known, or obvious.

In particular in Schumacher, the messages that are being combined are going to the same person. See, e.g., col. 3, lines 8-18, col. 10, lines 15-64. Thus, there would never be any concern about privacy that would justify the Examiner’s assertions that the relevant features would be obvious. It is only through improper hindsight that the Examiner has found obviousness, and no reasonable basis has been provided for combining the alleged “privacy” prior art with the Schumacher reference.

##### ***Claims 12 and 50***

These claims recite a sender rule that determines whether messages with particular business content may, or may not, be combined. The Examiner has acknowledged that Schumacher does not disclose these features, but asserts that

known privacy considerations would have made those features obvious. Even assuming that the unsupported motivation of “privacy” existed, there is no nexus between the alleged privacy considerations and the feature recited in the claims. The claims are directed to whether particular business content can be consolidated. There is no privacy concern that is being addressed by these features. Accordingly, the Examiner has not identified any prior art, or any relevant basis, for finding that these features were known, or obvious.

In particular in Schumacher, the messages that are being combined are going to the same person. See, e.g., col. 3, lines 8-18, col. 10, lines 15-64. Thus, there would never be any concern about privacy that would justify the Examiner’s assertions that the relevant features would be obvious. It is only through improper hindsight that the Examiner has found obviousness, and no reasonable basis has been provided for combining the alleged “privacy” prior art with the Schumacher reference.

For at least these reasons, it is submitted that the obviousness rejections of these claims based on Schumacher alone should be withdrawn.

#### **Rejections based on Schumacher and Johnson**

Claims 8-11, 20, 46-49 and 58 stand rejected under 35 U.S.C. § 103(a) as obvious over Schumacher in view of U.S. publication 2004/0230523 to Johnson (“Johnson”). These rejected claims all depend from independent claims that are allowable over Schumacher for the reasons given above. Johnson fails to cure the deficiencies identified above for those independent claims. Thus these rejections should be withdrawn for the same reasons.

#### **Rejections based on Schumacher and Stepno**

Claims 25-27, 29, 63-65 and 67 stand rejected under 35 U.S.C. § 103(a) as obvious over Schumacher in view of U.S. publication 2002/0133472 to Stepno (“Stepno”). These rejected claims all depend from independent claims that are allowable over Schumacher for the reasons given above. Stepno fails to cure the deficiencies identified above for those independent claims. Thus, these rejections should be withdrawn for the same reasons.

**Rejections based on Schumacher, Stepno, and Johnson**

Claims 28, 30, 66, and 68 stand rejected under 35 U.S.C. § 103(a) as obvious over Schumacher in view of Stepno in further view of Johnson. These rejected claims all depend from independent claims that are allowable over Schumacher for the reasons given above. Stepno and Johnson fails to cure the deficiencies identified above for those independent claims. Thus, these rejections should be withdrawn for the same reasons.

**V. CONCLUSION**

For these reasons, it is submitted that claims 2-5, 8-16, 19–37, 39-43, 46-54, and 57-75 should be found allowable in view of the asserted references. It is respectfully submitted this application is in a condition for allowance. Please contact the undersigned representative if there are any questions regarding this application.

Respectfully submitted,

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